

REMARKS

Applicants respond herein to each of the issues raised in the Office Action.

Applicants appreciate the indication of allowance of Claims 12-20, 34-43 and 45 and the indication of patentable subject matter in Claims 4-11 and 26-33. Claims 2, and 24 have been amended to place them in independent form. Accordingly, Claims 1 and 21 have been canceled and the dependency of Claims 22 and 23 has been changed. Claim 44 has been amended to include recitations related to selection of the frequency hopping mode similar to those found in Claims 2 and 24. Applicants submit the rejected claims, as amended, are allowable for the reasons discussed below.

Information Disclosure Statement Filed November 06, 2001:

Applicants note that the Examiner did not return an initialed copy of the Information Disclosure Statement (IDS) filed November 6, 2001. This IDS was submitted twice and then submitted a third time as an attachment to the Amendment filed December 10, 2004, wherein the Applicants requested acknowledgment of consideration of the November 6, 2001. A copy of the November 6, 2001 IDS is attached for the Examiner's reference along with a copy of the stamped postcard showing receipt thereof by the United States Patent Office on February 4, 2002. Applicants respectfully request that the Examiner return a copy of the PTO-1449 showing consideration of the references listed thereon with any subsequent communication in this matter.

The Prior Art Rejections:

Claims 1, 21-23 and 44 stand rejected under 35 U.S.C. § 102(e) as anticipated by United States Patent No. 6,223,053 to Friedmann et al. ("Friedmann"). Office Action, p. 2. Claims 2, 3, 24 and 25 stand rejected under 35 U.S.C. § 103 as obvious over Friedmann in view of United States Patent Application No. 2003/0206561 to Schmidl et al. ("Schmidl"). Office Action, p. 3. In light of the amendments to the claims above, the Section 102 rejections are obviated. Applicants submit that the claims are patentable over Friedmann and Schmidl because these references cannot properly be combined in the manner relied on in the

rejections of Claims 2, 3, 24 and 25 as discussed more fully below.

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest all the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). As discussed in further detail below, Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness as a proper motivation to combine the references in the manner cited in the

claims has not been established.

The Office Action asserts that the references can be combined because it would have been obvious to incorporate Schmidl's "selection of a communication scheme according to quality of the link" in Friedman "in order to use effectively the communication medium." Office Action, p. 3. No other basis is provided for the combination nor is there any citation to any portion of either reference to support the alleged motivation to combine.

In fact, Friedmann and Schmidl appear to be directed to different wireless communication contexts and problems. Friedmann is directed to a "universal radio" that "can be used in combination with the cellular communication systems provided by different manufacturers." Friedmann, Abstract. Thus, the objective appears to be to allow a terminal to match the protocol used by a cellular communication provider available to the terminal. The only discussion of providing "optimum performance" noted by Applicants' representative is related to the ability of the universal radio to switch between a spread spectrum communication protocol (referred to as "direct sequence (DS) spreading") and frequency hopping. Friedmann, Col. 1, lines 51-53; Col. 3, lines 9-15. In other words, Friedmann, if anything, suggests changing a transmission scheme based on noise conditions.

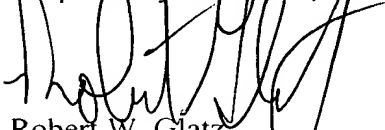
In contrast, Schmidl relates to "high rate wireless personal area network (WPAN)" requirements. Schmidl, ¶¶ 4-5. On a given WPAN, different data rates and coding are provided for different applications, such as audio, video and computer graphics. Applicants' representative noted no discussion of matching to different cellular network providers protocols with a universal terminal in Schmidl. Thus, while Schmidl may discuss selecting its WPAN protocols based on a quality measure of a channel, there is no discussion of separately modifying a transmission protocol and a frequency hopping mode. Applicants submit that, given the discussion in Friedmann of swapping between spread spectrum and frequency hopping to optimize performance, one of skill in the art would not be motivated to combine Friedmann with Schmidl in the manner relied on in the rejections. Accordingly, the rejections of Claims 2-3, 22-25 and 44 should be withdrawn for at least these reasons.

In re: Khayrallah et al.
Serial No. 09/800,143
Filed: March 6, 2001
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CONCLUSION

Applicants respectfully submit that, for the reasons discussed above, the references cited in the present rejections do not disclose or suggest the present invention as claimed. Accordingly, Applicants respectfully request allowance of all the pending claims and passing this application to issue. Applicants also, again, respectfully, request a signed copy of the PTO-1449 discussed above to show consideration thereof by the Examiner.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on August 3, 2005.



Carey Gregory